

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent Application of:  
Scott Lascelles et al.

Application No.: 09/991,894

Confirmation No.: 4186

Filed: November 13, 2001

Art Unit: 3694

For: ON-LINE BALANCE TRANSFERS

Examiner: S. Malhotra

**RESPONSE TO RESTRICTION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction and election requirement set forth in the Office Action mailed August 25, 2009, applicants elect with traverse invention I, claims 1-13, for examination. Applicants respectfully traverse the restriction on the following grounds.

First, inventions I, II and III cannot be restricted on grounds that they are subcombinations usable together in a single combination. The claims of group I are directed to a method. The claims of group II are directed to an apparatus, and the claims of group III are directed to an article of manufacture. It is respectfully submitted that a method and either an apparatus or article of manufacture, cannot be subcombinations usable together in a combination. A combination is an organization of which a subcombination or element is a part. Manual for Patent Examining Procedure §806.05(a). Steps of a method cannot be elements of an apparatus, and *vice versa*. It is submitted that, if the method claims of group I are to be restricted from the apparatus claims of group II, the criteria set forth in M.P.E.P. §806.05(c) must be followed. It has not been. Therefore, the restriction is in error for at least this reason.

Second, the examiner must provide reasons and /or examples to support conclusions. M.P.E.P. §803.

It is submitted that the examiner fails to provide any evidence or reasoning sufficient to support his contention that the alleged subcombinations are distinct. The examiner merely states that the invention of group I is a method and supports his contention that groups II and III have separate utility by simply copying the claims. These are merely conclusions and are devoid of any reasoning in support of them. He further argues that the group II invention can be practiced by “telephone, facsimile and hand (manually).” Not only does the examiner fail to provide any explanation of the relevance of this statement to the issues, but also the statement is incorrect. Claim 14, which is part of group II, is directed to a system comprising a configured computer and a network connection.

Finally, the examiner has not made a *prima facie* showing that there would be a serious search and examination burden if restriction was not required. Claims 1, 14 and 16 were each previously examined and have not been substantively changed. If it was not a serious burden before, there is no reason for it to be a serious burden now. The examiner has only supplied a list of generic types of reasons that can be used to support this restriction without giving any specific facts to support application of any of the listed reasons to the present situation.

Applicants note that there appears to be an arbitrary change in the subclassification of the claims placed in groups II and III. All three groups remain in class 705. However, the examiner has apparently moved from class 705, subclass 39, inventions II and III to, respectively, class 705, subclasses 21 and 17. No explanation is given for changing the subclasses. Indeed, subclasses 21 and 17 appear to relate to the use of electronic cash registers, subclass 17 further requiring an interface for a record bearing medium or carrier for electronic funds transfer payment or credit (for example, a card reader). It is not clear where in the claims of groups II and III there is a limitation to an electronic cash register, much less, in the case of group III, one that has something like a card reader. As claims 14 and 16 (the independent claims of groups II and III, respectively) have not been substantively amended, much less amended to recite electronic cash registers, the apparent

change in subclasses appears to be arbitrary. Furthermore, if such claims were always in these subclasses, the different subclasses do not support the contention that there is a serious burden given that each of these inventions has been, presumably, previously searched. Furthermore, even if the separate subclassification for groups II and II is correct, no serious burden has been shown in searching each of these two subclasses.

Therefore, the examiner's evidentiary burden has not been met. It is respectfully submitted the search and examination burden would not be serious.

In view of these errors, Applicants respectfully traverse the restriction and election requirement.

Dated: November 25, 2009

Respectfully submitted,

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